

ELECTION

Applicant elects, with traverse, what the Examiner has characterized as “Invention IV”, deemed drawn to a welding-type device, and corresponding to claims 39-52.

REMARKS

The Examiner has identified four ‘inventions’ in the pending claims. The Examiner’s classification of the ‘inventions’ include Group I consisting of claims 1-13 drawn to a gas cylinder and classified by the Examiner in class 431, Group II consisting of claims 14-20 drawn to an adapter and classified by the Examiner in class 428, Group III consisting of claims 21-38 drawn to a shielding gas system and classified by the Examiner in class 228, and Group IV consisting of claims 39-52 drawn to a welding type device and classified by the Examiner in class 219.

This is the second Restriction Requirement imposed by the Examiner in this matter. In the first Restriction Requirement of June 27, 2006, the Examiner had originally identified two inventions in the pending claims, with Invention I consisting of claims 1-13 and 21-52 and being drawn to welding, and Invention II consisting of claims 14-20 and being drawn to an adapter. Although Examiner has not provided any explanation as to why this additional restriction is now required over the first restriction, Applicant wishes to address these new restrictions here below.

In the present Restriction Requirement, the Examiner states that “[t]he inventions are distinct, each from the other....” *Office Action, October 4, 2006, p. 2, sec. 1*. However, the Examiner states that the Inventions are unrelated and applies MPEP 806.06, which pertains to independent inventions, not distinct inventions.

Regardless of this, Applicant respectfully disagrees with the Examiner’s conclusion the identified inventions are unrelated. As stated in MPEP §802.01.I, “[t]he term “independent” (i.e., not dependent) means that there is no disclosed relationship between the two or more **>inventions claimed<**, that is, they are unconnected in design, operation, **>and< effect>**.” (Emphasis added). Thus, the Examiner has the burden to show that the inventions are unconnected in (1) design, (2) operation and (3) effect.

The Examiner stated that the Inventions I and III are unrelated because “[i]n the instant case, the different inventions are a gas cylinder and a shielding gas system.” *Office Action, supra at 2*. The Examiner’s assertion that Invention I is drawn to a gas cylinder and that Invention III is drawn to a shielding gas system, followed by a statement that the Inventions are different merely

because Invention I is a gas cylinder and Invention III is a shielding gas system, does not satisfy the Examiner's burden to show different designs, operations, and effects. A review of the subject matter of the two Inventions in its entirety clearly shows that the Examiner cannot show independent inventions. Such a review indicates that the Inventions are not independent from one another and that the similarities between the claim elements cannot lead to a logical conclusion that the Inventions are unconnected in design, operation and effect. It appears that the Examiner is basing the restriction of Inventions I and III merely on the preamble of the claims associated with these Inventions without giving any regard to the subject matter therein. Accordingly, at least for the reasons set forth above, Applicant believes that the restriction between Inventions I and III is improper.

The Examiner follows a similar rationale for the restriction between Inventions I and IV, asserting that they are unrelated in that the different inventions are a gas cylinder and a welding type device. Again, the Examiner has not satisfied the burden to show different designs, operations, and effects set forth in MPEP §802.01.I. A simple statement that the Inventions are different merely because the preamble of claim 1 calls for a gas cylinder and the preamble of claims 39 and 51 call for a welding type device, does not satisfy the Examiner's burden to show different designs, operations, and effects. A review of the subject matter of the two Inventions in its entirety, beyond just the preambles, again clearly shows that the Examiner cannot show independent inventions.

The same restriction is made between Inventions III and IV, as the Examiner again states that the Inventions are unrelated in that they are a shielding gas system and a welding device. Again, a review of the subject matter of the Inventions in its entirety indicates that the Examiner cannot show independent inventions. For the same reasons set forth above, the Examiner has not satisfied the burden required to support such an assertion.

In addition, the Examiner states that the Inventions are independent or distinct because they "require a different field of search"...." *Office Action, supra at 2*. As stated in MPEP 808.02, "[w]here the related inventions as claimed are shown to be >independent or< distinct under the criteria of MPEP § 806.05(c) - >§ 806.06<, the examiner, in order to establish reasons for insisting upon restriction, must >explain why there would be a serious burden on the examiner if restriction is not required." In order to do so, the Examiner must show "by appropriate explanation" that, in this case, the inventions require a different field of search. *See id.* The Examiner has not met that burden here. Merely stating that a different field of search is required, without more, does not appropriately explain why there would be a serious burden on the

Examiner if restriction is not required. A review of the subject matter shows that a different search is not required between inventions.

The Examiner follows a similar rationale as that described above for each of the other restrictions imposed. That is, the Examiner states that:

- Inventions I and II are unrelated in that the different inventions are a gas cylinder and an adapter.
- Inventions II and III are unrelated in that the different inventions are an adapter and a shielding gas system.
- Inventions II and IV are unrelated in that the different inventions are a welding type device and an adapter.

For each of these separate assertions, the Examiner does not satisfy the burden to show different designs, operations, and effects between the inventions.

For all these reasons, Applicant respectfully requests rejoinder of all claims, of each group. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,

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